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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/815.556 03/12/97 SULLIVAN

M DLD-2-035-1

EXAMINER

QM21/0506

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ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Application No.: 08/815,556

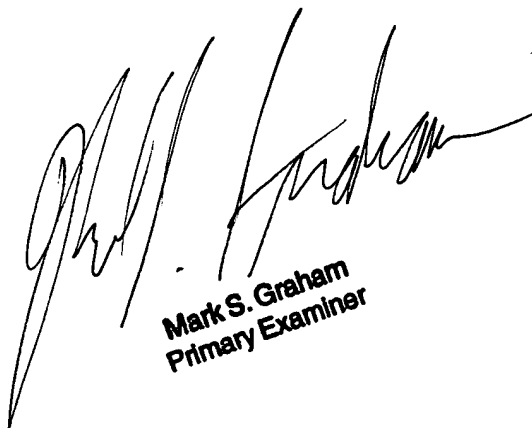
Art Unit: 3711

The reply brief filed 2/5/99 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number (703) 308-1355.

MSG

April 26, 1999



Mark S. Graham
Primary Examiner

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. SULLIVAN

MAILED

Appeal No. 1999-2736
Application No. 08/815,556

SEP. 17 2001

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

ON BRIEF

Before MCCANDLISH, Senior Administrative Patent Judge, and NASE and CRAWFORD,
Administrative Patent Judges.

MCCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 13.
No other claims are pending in the application.

Appellant's invention relates to a golf ball having a two-ply cover construction formed by an inner cover layer (14) and an outer cover layer (16). The inner cover layer comprises a ionomer having a high acid content of at least 16% by weight (see claim 1).¹ The outer cover

¹ Claim 1 and at least one passage in the specification (see page 10) state that a high acid ionomer has an acid content of at least 16% to thus include an acid content of 16%. In contrast, other passages in the specification (see,

layer comprises a soft polymeric material. The high acid content of the ionomeric inner cover layer is said to enhance the resilience of the ball to improve the carrying distance of the ball.² The soft outer cover layer is said to provide desirable playability characteristics (e.g., "spin", "feel", etc.).

A copy of the appealed claims is appended to appellant's brief.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejection under 35 U.S.C. § 103:

Nesbitt	4,431,193	Feb. 14, 1984
Nakamura	5,068,151	Nov. 26, 1991

Claims 1 through 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nesbitt in view of Nakamura. In his answer (see page 3), the examiner refers us to Paper No. 2 (the Office action mailed April 8, 1994 in appellant's grandparent application)³ for a discussion of this rejection. According to this Office action (see page 2), "Nesbitt discloses the claimed invention with the exception of the particular materials utilized." In his answer (see page 4), the examiner states that he relies upon the Nakamura patent for its teaching that ionomers having an acid content in the 10 to 20% range are "known in the art." From this finding, the examiner concludes that it would have been obvious to utilize such a material in the two-ply golf ball of Nesbitt, presumably as a replacement for Nesbitt's inner cover layer.

for example, pages 6 and 10) state that the acid content of a high acid ionomer is required to be greater than 16% to thus exclude an ionomer having an acid content of 16%. A review of appellant's specification and claims is in order upon return of this application to the Technology Center for the purpose of clarifying this apparent inconsistency.

² Resilience is equated to the coefficient of restitution of the ball. See, for example, page 8 of appellant's specification.

³ The examiner has not represented that the claims pending in the grandparent application at the time of the office action dated April 8, 1994 are the same as the claims involved in the instant appeal to justify the referral to this office action for a discussion of the rejection involved in this appeal.

We have carefully considered the record before us together with the examiner's remarks and appellants' arguments. As a result, we conclude that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness.⁴ To establish a prima facie case of obviousness, the examiner must show that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art would have led that person to combine the relevant teachings of the references in a way to arrive at the claimed invention. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The Nesbitt patent discloses a golf ball having inner and outer cover layers. The outer layer is made from a soft resinous material to enhance the playability characteristics of the ball (see column 1, lines 51-56 of the Nesbitt specification) similar to appellant's outer cover layer. Like appellant's inner cover layer, Nesbitt's inner cover layer is also made from an ionomeric resin to enhance the coefficient of restitution (see column 2, lines 59-62 of the Nesbitt specification).

However, according to the description on page 4 of appellant's specification, the examples of the ionomeric resins disclosed in Nesbitt to make the inner cover layer are not high acid ionomers and, instead, are low acid ionomers having an acid content equal to or less than 15%. The examiner has not challenged this description. Nor has the examiner challenged appellant's argument on page 5 of the main brief that the Nesbitt's ionomeric resins are low acid resins. Based on this record, therefore, independent claims 1 and 13 differ from Nesbitt by reciting that the ionomeric inner cover layer has an acid content of at least 16%, and claim 13,

⁴ In view of this conclusion, the examiner's refusal to enter the evidence of nonobviousness introduced with appellant's main brief and appellant's supplemental brief (see page 2 of the answer) becomes moot. In any case, the examiner's action refusing to enter this evidence is a procedural matter reviewable by petition rather than by appeal to this Board. See In re Hengehold, 440 F. 2d 1395, 1403-1404, 169 USPQ 473, 479 (CCPA 1971).

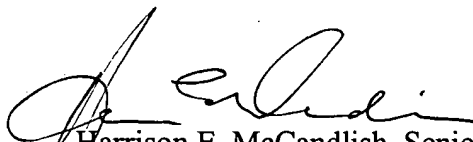
the only other independent claim on appeal, differs from Nesbitt by reciting that the ionomeric inner cover layer has an acid content in the range from about 17% to about 25 %.


The Nakamura reference discloses a golf ball having a single cover layer forming the outer covering of the ball. According to the Nakamura specification, the outer covering is made from an ionomeric resin having an acid content in the range extending from a low acid content of 10% by weight to a high acid content of 20% by weight. Nakamura thus lacks a teaching of providing an inner ionomeric cover layer in a two-ply cover with a high acid content. Just because high acid ionomers are known in the prior art, it does not necessarily follow that it would have been obvious to select such a material for the purpose of making Nesbitt's inner cover layer.


What is lacking in the cited prior art is a teaching or suggestion that an increase in the acid content in the inner ionomeric cover layer into the high acid range will increase the resilience of the golf ball. Lacking such a suggestion, the only way the examiner could have arrived at his conclusion of obviousness is through hindsight based on appellant's teachings. Hindsight analysis, however, is clearly improper. In re Deminski, 796 F.2d 436, 443, 230 USPQ 313, 316 (Fed. Cir. 1986).

The examiner's decision rejecting appealed claims 1-13 under 35 U.S.C. § 103 is reversed.

REVERSED


Harrison E. McCandlish, Senior
Administrative Patent Judge


Jeffrey V. Nase
Administrative Patent Judge


Muriel E. Crawford
Administrative Patent Judge

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